REMARKS

This is intended as a full and complete response to the Office Action dated May 16, 2005, having a shortened statutory period for response extended to expire on November 16, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 12-14 and 26 are pending in the application. Claims 12-14 and 26 remain pending following entry of this response.

Double Patenting

Claims 12-14 and 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent Application Publication No. 2002/0129356 by *Hellerstein et al.* (hereinafter *"Hellerstein"*). Applicants respectfully traverses this rejection.

Legal Standard:

Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is **not patentably distinct** from the subject matter claimed in a commonly owned patent, or a non-commonly owned patent but subject to a joint research agreement as set forth in 35 U.S.C. 103(c)(2) and (3), when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d *>1869< (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000). (*See* also MPEP 804 II.B.1).

Ownership:

As an initial matter, and pursuant to any requirement under 37 CFR 1.56, Applicants submit that the present application has been assigned to Lenovo, Inc. and that the *Hellerstein* application is assigned to International Business Machines Corporation. Accordingly, Applicants submit that the present application and the *Hellerstein* application are not currently commonly owned.

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Patentably Distinct Subject Matter:

Further, Applicants submit that the claimed subject matter of the present application is patentably distinct from the claimed subject matter of *Hellerstein.* In general, the claimed subject matter is fundamentally different from the claimed subject matter of *Hellerstein* in that *Hellerstein* "provides a methodology for staged distribution to minimize network bandwidth requirements and the adverse effect of single point of failure." Paragraph [0010]. This aspect of *Hellerstein* is clearly claimed in claims 1 and 3 and 10 and 19, relied upon by the Examiner, and no variant of this aspect is present in the Applicants' claims. This difference is highlighted in the following table:

Applicants' Claim 13	*Hellerstein's* Claim 1
- receiving, **by a supplier system,** a software inventory from the customer system;	- preparing a base software package for each of the one or more regions...; *[Performed by service distribution server]*
- verifying one or more business contracts for the software inventory **utilizing one or more databases connected to the supplier system;**	- distributing the base software package to each of the candidate regions of the distributed network; *[Network transmission from the service distribution server to the candidate regions]*
- determining one or more software upgrade releases for the software inventory **utilizing a product topology database connected to the supplier system;**	- customizing the base software package received at each of the candidate regions...; *[Performed at the respective candidate regions]*

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From the foregoing table it can be appreciated that the identified steps of the Applicants' claims are performed by a supplier system, and on the basis of databases connected to the supplier system. Such a processing environment is fundamentally incompatible with the claimed multi-tiered processing environment of *Hellerstein* in which a base software package is prepared by one entity, then distributed to a plurality of candidate regions of a distributed network, and then customized by each of the candidate regions. On this basis alone, Applicants submit that the present claims are not obvious variants of the *Hellerstein* claims.

Another fundamental difference between the Applicants' claims and the *Hellerstein* claims is that *Hellerstein* begins by preparing a base software package applicable to multiple regions each having multiple individual target machines, and then subsequently customizes the base software package on the basis of various information. In other words, *Hellerstein* begins with a generally applicable base software package that is not particular to any specific machine, and subsequently customizes of this software package for given machine. (See, Table above.) In contrast, the Applicants' claims recite receiving a software inventory from a particular customer system, and then determining one or more software upgrade releases for that particular received software inventory. Thus, nothing in *Hellerstein's* claims makes obvious the Applicants' act of "determining one or more software upgrade releases for the software inventory [that was received from a customer system]." Still further, nothing in *Hellerstein's* claims makes obvious the Applicants' act of "determining one or more software upgrade releases for the software inventory [that was received from a customer system] utilizing a product topology database connected to the supplier system". At a minimum, this is because in *Hellerstein* a base software package is customized on the basis of "(i) regional distribution policies, (ii) dependency information specific to one or more roles performed by the target machines in that region, and (iii) individual target machine configuration information..." (Claim 1 of *Hellerstein*), not on the basis of a "product topology database" (Claim 13 of present application).

In this regard, Applicants note that the Examiner's claim chart is flawed. The Examiner suggests the following relationships:

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Applicants' Claim 13	*Hellerstein's* Claims 1 + 3
determining one or more software upgrade releases for the software inventory utilizing a product topology database connected to the supplier system;	The method of claim 1, wherein the dependency information indicating requisites for a service provided by the software package is represented in the form of a multilevel tree; (Claim 3)
verifying prerequisite and corequisite software for the additional software.	dependency information indicating requisites for a service provided by the software package; (Claim 1) customizing the base software package received at each of the candidate regions based on at least one of: (ii) dependency information specific to one or more roles performed by the target machines in that region; (Claim 1)

Note that the recitations of *Hellerstein's* claim 3 refer back to the "dependency information" of *Hellerstein's* claim 1. However, the Examiner relates *Hellerstein's* recitations of "dependency information" from claim 1 to the "verifying" step of the present claim 13. In other words, the Examiner is applying the same limitation ("dependency information") to two distinct steps of the Applicants' claims. Respectfully, this is inappropriate and the rejection should, therefore, be withdrawn.

Further, nothing in the Applicants' claims is an obvious variant of *Hellerstein's* steps of "preparing a base software project for each of the water more regions" and "customizing the base software package received at each of the candidate regions". Applicants' claims are not directed to, or suggestive of, dealing with regions or a multi-tiered distribution system, which are essential limitations of *Hellerstein*. Applicants' claims are directed to determining software upgrade releases for <u>a given customer system</u> on the basis of a received inventory. Preparing a software package for a region,

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and subsequently customizing the base software package, therefore, find no obvious counterparts in the Applicants' claims.

Perhaps most significant are the assertions of inherency made the Examiner. First, the Examiner states that:

> "The limitation of present claim 13 this is lacking in publication claim 1 + 3 is that of "receiving an order for additional software." However, this limitation is deemed inherent to the method of publication claims 1 + 3 as these claims recite the steps of preparing, customizing and distributing a base software package. Without the receiving the order of additional software step, there is no need for the steps of preparing, customizing and distributing a base software package." *Examiner's Action, pages 5-6.*

Respectfully, the Examiner errs in this analysis and conclusion. An argument on the basis of inherency requires that the suggested inherent aspect <u>necessarily</u> be present. MPEP §2112 (IV). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art." *Ex parte Levy,* 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). In this case, *Hellerstein* is fundamentally a push-type technology. That is, explicit requests from the target machines of *Hellerstein* are not received in order to prepare, customize and distribute a base software package. *Hellerstein* teaches that "even though a target machine may qualify for an update, the user may not want such an update for various reasons ... [accordingly, an] update flag is a mechanism available to the user to stop an update." Paragraph [0080]. Thus, contrary to the Examiner's suggestion, receiving an order for additional software is not a prerequisite to the preparing, customizing and distributing of a base software package, as taught by *Hellerstein.* It follows, therefore, that receiving an order for additional software is not inherent in preparing, customizing and distributing of a base software package. In fact, *Hellerstein* is specifically designed to distribute a software package without first receiving requests from the target machines.

Second, the Examiner states that:

> "The limitations of the publication claim 1 + 3 that are lacking in present claim 1 [*sic*] are "distributing the base software package to each of the candidate regions of the distributed network" and "distributing the software package customized in each of the candidate regions to at least one of the target machines in the candidate regions of the

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distributed network." However, these two steps are deemed inherent to the method of present claims 13 because the method of present claim 13 relates to the upgrading of software on a customer system, which requires, *inter alia*, sending in order for software and receiving by the supplier system a software inventory of the customer system. Without the distributing steps, the customer system could not receive the ordered software package." *Examiner's Action, page 6.*

Respectfully, the Examiner errs in this analysis and conclusion. As pointed out above, *Hellerstein's* claims are performed in a multitiered networked environment. As claimed, the base software package is first distributed to each of the candidate regions and then the customized software package is distributed from the candidate regions to target machines). No such multitiered distribution is inherent in the Applicants' claims. At least one embodiment within the scope of claim 13 is that, once the one or more software upgrade releases for the software inventory are determined, the releases are provided to the customer system. The steps of "distributing the base software package to each of the candidate regions of the distributed network" and "distributing the software package customized in each of the candidate regions to at least one of the target machines in the candidate regions of the distributed network" are neither inherent nor even suggested by the present claim 13.

In this regard, Applicants note a fundamental confusion in the present Office Action. Specifically, the Examiner appears to focus only on the teaching of "distributing" in the foregoing claims, while disregarding what is being distributed. The first distributing step is of the base software package. The second distributing step is of the customized software package. By definition, these are not the same packages. Accordingly, even assuming a distributing step is inherent to the method of present claim 13, it does not follow that two separate distributing steps of two different items is inherent.

The above analysis is largely applicable to the Examiner's rejection of claim 14.

Regarding claims 12 and 26, the Examiner states that "the method steps of verifying pre-requisite and co-requisite software for the software upgrade releases (filtering, categorizing, mapping, categorizing and generating...) recited in present claims 12 and 26 are not patentably distinct from the method of verifying dependency information indicating requisites for the service provided by the software package

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recited in publication claims 1 + 3 and 22." Applicants note two fatal flaws. First, publication claims 1 + 3 and 22 do not recite a step of "verifying dependency information indicating requisites for the service provided by the software package", as suggested by the Examiner. Second, the Examiner seems to suggest that the Applicants' steps of filtering, categorizing, mapping, categorizing and generating are substeps of the Applicants' verifying step. Respectfully, the Examiner errs – the steps of filtering, categorizing, mapping, categorizing and generating are distinct steps relative to the Applicants' verifying step in claims 12 and 26. Therefore, the rejection is improper.

For all these reasons, individually and collectively, the rejection is believed to be improper. Accordingly, Applicants respectfully request that the rejection be withdrawn and the claims be allowed.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,

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